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Supreme Court of the United States

October Term, 1949.

No. 765

FRANCIS H. MONTMARQUET, d/b/a
O. C. MANUFACTURING COMPANY,

Petitioner,

—against—

JOHNSON & JOHNSON,

Respondent.

REPLY TO RESPONDENT'S OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

MORRIS KIRSCHSTEIN,
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JACOB T. BASSECHES,
JAMES V. MCNAMARA.

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I.

Respondent has not met the basic issue presented in this petition, namely, whether summary judgment properly can be granted under Rule 56, holding a patent invalid for lack of invention in view of the prior art. This is made clear by the very cases on which respondent relies. In *U. S.* v. *Esnault-Pelterie,* respondent's brief, page 4, the very language quoted shows that "all the evidence (was) before the Court." Indeed a full trial (hearing before the Court of Claims) with special findings, 303 U. S., page 27, had been had.

Validity is an issue of fact (see Petitioner's brief, page 10 and page 2, *infra*). Here, petitioner was precluded from offering full evidence on this issue. A patentee should not be restricted to merely what he can develop on affidavits in resisting a motion for summary judgment.

He is entitled to a full trial in open court where all available evidence could be submitted.

The other cases relied on by respondent, *Singer Co.* v. *Cramer* and *Ryan Distributing Corp.* v. *Caley* (Respondent's brief, pages 4 and 5) are also clearly cases where all the evidence was before the Court. In each of these cases there had been a full trial on the merits. Here, the petitioner has been precluded from trial altogether.

II.

Moreover, *Singer Co.* v. *Cramer* dealt only with the issue of infringement. Cases granting motions for summary judgment for non-infringement are outside the conflict of authority referred to in the petition. Such cases (to quote from *American Optical Co.* v. *New Jersey Optical Co.*, 58 Fed. Supp. 601, 605) relate

> "* * * to the construction or interpretation of the patent claims, i.e., whether a given element is or is not included within the claim. Determination of the meaning of the patent claims can be made from the face of the instrument, as in a written contract. This involves questions of law for the Court, not of fact for a jury." (Citing *Coupe* v. *Royer,* 155 U. S. 565 and *Singer Mfg. Co.* v. *Cramer.*)

Validity, in contrast with infringement, has repeatedly been held by this Court to present a question of fact. See the very cases referred to in *U. S.* v. *Esnault-Pelterie,* 303 U. S., page 31, immediately following the quotation relied on by respondent on page 4 of its brief; to-wit: *Bischoff* v. *Wethered,* 9 Wall. 812, 815, 816; *St. Paul Plow Works* v. *Starling,* 140 U. S. 184, 196, 197; *Coupe* v. *Royer,* 155 U. S. 565, 577-80.

III.

Respondent insists that here there was no genuine issue of fact and at pages 5 to 6 of its brief seeks to differentiate petitioner's cases by pointing in some of these cases to the presence of affidavits of fact in opposition and contradicting affidavits of experts whereby such an issue was created. Respondent appears to have lost sight of the fact that in this case, too, affidavits were presented in opposition to the motion for summary judgment (Petition, page 4) and that these affidavits were not controverted.

Respectfully submitted,

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